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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/209,932

07/08/98

BAHAR

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0769-4582-US

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EXAMINER

COPENHEAVER, B

ART UNIT

PAPER NUMBER

1771

9

DATE MAILED:

10/22/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/209,932

Applicant(s)

Bahar et al.

Examiner

Blaine R. Copenheaver

Group Art Unit

1771



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

☒ Claim(s) 99-254 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 99-254 are subject to restriction or election requirement.

### Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The numbering of claims is not accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 100-226 (first claim number "226") been renumbered as claims 99-225. As correctly noted in the second preliminary amendment, the first preliminary amendment contained two claims numbered "27." However, it appears as though the applicant failed to recognize that the first preliminary amendment also did not have a claim number "90." Thus, when the Patent Office renumbered the claims of the first preliminary amendment, only claims 27 (second claim number "27") to 89 were renumbered. Thus, after the first preliminary amendment, claims 27-98 were present in this application. Thus, all of the claims in the second preliminary amendment have been renumbered as claims 99-188. In the third preliminary amendment, the applicant provided two claims numbers as "226." Thus, the examiner has renumbered claims 190-226 (first claim number "226") as claims 189-225.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 99-143, 172-179, 189-216, 233-240, and 245-254 are drawn to a composite membrane, classified in class 428, subclass various.

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II. Claims 144-162, 171, 182-184 (?), 217-227, and 241-244 (?) are drawn to a method of manufacturing a composite membrane, classified in class 427, subclass various.

III. Claims 163-170, 185-188 (?), and 228-232 are drawn to a fuel cell, classified in class 429, subclass various.

3. It is noted that it is unclear which Group claims 182-188 and 241-244 belong to, because they are drawn to a composite membrane, but depend on either a method or fuel cell claim. The applicant is required to clarify this issue in response to this Office Action.

4. The inventions are distinct, each from the other because of the following reasons: Inventions Group II and Groups I & III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the composite membrane can be made by another and materially different process, such as a process that does not repeat step (b) or a process that only applies an ion exchange solution to one of the major surfaces of the support.

5. Inventions Group I and Group III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the

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intermediate product is deemed to be useful as a diffusion dialysis membrane or a membrane suitable for use in other processes (See page 1 of the specification) and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blaine R. Copenheaver whose telephone number is (703) 308-1261. The examiner can normally be reached on Tuesday-Friday from 6:30 AM-4:00 PM and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Terrel H. Morris, can be reached at (703) 308-2414. The fax numbers for Technology Center 1700 are (703) 305-7718 and (703) 305-3601.

  
**Blaine R. Copenheaver**  
**Primary Examiner**  
**Art Unit 1771**

B. Copenheaver  
October 21, 1999